

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GREGORY A. SHANAHAN and KEVIN L. RUTKOWSKI

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Appeal No. 1997-2942  
Application 08/281,958

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ON BRIEF

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Before FLEMING, LALL, and BARRY, Administrative Patent Judges.  
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection<sup>1</sup> of claim 12, all the other claims having been canceled.

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<sup>1</sup>An amendment after the final rejection was filed as paper no. 11 and was approved for entry by the Examiner [paper no. 12].

The disclosed invention comprises a flexible, stretchable, compressible, twistable material and has a tubular section with grommets, one at each end. The tubular section has a uniform wall thickness and is formed with an integral, radially outwardly projecting, screw-like helical formation extending substantially throughout its full length. This construction enables the conduit to be twisted without kinking or buckling. The invention is further illustrated by the following claim.

12. The method of mounting an open-ended conduit for an electrical harness between a first panel having a first opening therein of predetermined size and shape and a second panel laterally spaced from said first panel and having a second opening therein of predetermined size and shape, comprising the steps of:

(a) providing an open-ended conduit for an electrical harness in the shape of an elongated tubular section having opposite ends and made of a flexible, stretchable, compressible, twistable material having a first integral grommet at one end of said tubular section of the same size and shape as said first opening and a second integral grommet at the opposite end of said tubular section of the same size and shape as said second opening, said second opening and said second grommet being non-circular, said tubular section being of uniform wall thickness and formed with an integral, radially outwardly projecting screw-like, helical formation extending throughout substantially the full length thereof;

(b) fitting said first grommet in said first opening;

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(c) aligning said second grommet with said second opening, and then twisting said conduit about its longitudinal axis in one direction such that the helical formation causes lengthening of the tubular section without kinking or in the opposite direction such that the helical formation causes shortening of the tubular section without kinking as needed to rotatably orient said second grommet to match the orientation of said second opening; and

(d) while said conduit remains twisted and said second grommet remains aligned with said second opening and rotatably oriented to match the orientation of said second opening, fitting said second grommet in said second opening.

The references relied on by the Examiner are:

Kramer et al. (Kramer)	3,131,954	May 5, 1964
Reuther et al. (Reuther)	3,151,905	Oct. 6, 1964

Foreign Patent

Redder (German Patent Publication)<sup>2</sup> 25 56 506 Jun. 23, 1977

Claim 12 stands rejected under 35 U.S.C. § 103 over  
Redder, Kramer, and Reuther.

Reference is made to Appellants' briefs<sup>3</sup> and the

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<sup>2</sup>Our decision is based on the English translation of this reference obtained by the U.S. Patent and Trademark Office. A copy of this translation is enclosed herewith.

<sup>3</sup>A reply brief was filed as paper no. 17 and its entry was approved without any further response by the Examiner [paper no. 18].

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Examiner's answer for their respective positions.

**OPINION**

We have considered the record before us, and we will reverse the rejection of claim 12.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories,

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Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985),  
cert. denied, 475 U.S. 1017 (1986); ACS Hosp. System. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Furthermore, the Federal Circuit states that "[the] mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fitch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (Citing W. Lish. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1551, 1553, 220 USPQ 311, 312-13 (Fed. Cir. 1983).

Analysis

We consider the sole claim in the case, claim 12. Reviewing the record, we find that the Examiner, in his rejection of the claim over Redder, Kramer, and Reuther, has simply picked from these references various pieces recited in the method steps of the claim and attempted to reconstruct the claimed invention, using the invention as a blue print. None of the references recognizes the problem being solved by Appellants, i.e., a tubular conduit having the capability of being twisted to increase or decrease its length to fit the grommets at each end in the circular or non-circular slots in the respective panels, without kinking the conduit. None of the cited references is concerned with any rotational movement of a conduit in order to fit a grommet at the end of the conduit into a corresponding slot in a panel [brief, page 8].

The Examiner, on his part, asserts [answer, page 5] that "[i]n this case, the obviousness is based on the finding that one of ordinary skill in the art would have common sense and the necessary mechanical skill to employ a specific tube known

in the art to obtain a specific characteristic." We disagree. The Examiner has not proffered any evidence that even shows the recognition of the problem being solved by the claimed invention, let alone a solution of the problem. Redder shows a rubber conduit 16 which is of a fixed length. There is no mention of any rotational movement (or twisting) of the conduit about its axis. Redder's conduit also does not have any helical spiral on the surface of the conduit, see figs. 2 and 4. Kramer shows a helical spiral on the surface of conduit 1, however, there is no rotational movement about its axis (i.e., twisting). Reuther is used by the Examiner to show the circular and non-circular grommets at the ends of a conduit, however, in Reuther, there is no need to twist the conduit because the grommets are inserted in the corresponding slots in the panels before the conduit is closed to form and hold the tubular shape with buttons 54 in the overlapping flanges 38 (see figs. 1, 2, and 8). Thus, there is a complete absence of the teaching of the claimed feature of twisting of the conduit without kinking the conduit.

Therefore, we do not sustain the obviousness rejection of

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claim 12 over Redder, Kramer, and Reuther.

In conclusion, the Examiner's decision rejecting claim 12  
under 35 U.S.C. § 103 is reversed.

**REVERSED**

MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	



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